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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/708,038	11/08/00	KHALFAN Z	1084-7/MBE

EXAMINER	
NGUYEN, T	
ART UNIT	**PAPER NUMBER**
3653	3

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DATE MAILED: 11/07/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
09/708,038	Zaheer Khalfan
Examiner	**Art Unit**
Tuan Nguyen	3653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three (3) MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on 11/08/00

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1 – 22 is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideratio

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1 – 22 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claims _____ are subject to restriction and/or election requirement

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13)☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a)☒ All b)☐ Some* c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15)☒ Notice of References Cited (PTO-892)

16)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

17)☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

18)☐ Interview Summary (PTO-413) Paper No(s). _____

19)☐ Notice of Informal Patent Application (PTO-152)

20)☐ Other:

DETAILED ACTION

1. Claim 21 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 21 recites the limitation "the air nozzle" in line 1. There is insufficient antecedent basis for this limitation in the claim.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-6 and 8-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Shields et al..

Shields et al. disclose a detection device and a method for differentiating between a material containing less than a selected amount of lignin and a material containing more than the selected amount of lignin (column 1, lines 12-19 and lines 53-57). The device and method comprise a light source 28 and 94 having an ultraviolet component positioning to emit light to strike the material; a detector 24 for detecting ultraviolet light and generating an electrical signal proportional to an intensity of detected ultraviolet light; an optical filter 25 and 26 to eliminate components of diffusely reflected light outside of the ultraviolet range; and an instrument 30 for measuring a level of the electrical signal. The material is a paper product 22.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 7 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shields et al..

Shields et al. do not disclose a claimed equation in claims 7 and 14 to determined the amount of lignin.

However, it would have been obvious to one skill in the art to modify the device and method of Shields to have such claimed equation since it is an obvious mathematical equation well known in the art to determine the amount of lignin in a paper product.

7. Claims 15-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shields et al. in view of McGarvey.

Shields et al. have been discussed in paragraph 3 above. However, Shields et al. do not have a conveyor and do not have an ejection device.

McGarvey discloses an apparatus and a method for detecting and sorting flat products such as potato chips comprising a conveyor 18 for conveying the products and an ejection device 38 having a plurality of air nozzles.

It would have been obvious to one skill in the art to modify the device and method of Shields et al. to have a conveyor and an ejection device as taught by McGarvey. Such conveyor is for conveying the products and the ejection device is for separating products into acceptable and unacceptable products.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Millar et al., Howarth, Selander and Eason are cited to show other pertinent art.

9. Any inquiry concerning this communication should be directed to Examiner Tuan Nguyen at telephone number (703) 308-3664.

Tuan N Nguyen

tnn,

November 02, 2001.

TUAN N. NGUYEN
PRIMARY EXAMINER

11/2/01